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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,906	10/29/2003	Albert K. Chin	26448-07961	9199

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EXAMINER	
BERTRAM, ERIC D	

ART UNIT	PAPER NUMBER
3766	

MAIL DATE	DELIVERY MODE
08/29/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/697,906	CHIN ET AL.	
	Examiner	Art Unit	
	Eric D. Bertram	3766	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *08 July 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *17 and 18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *17 and 18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/22/2008 has been entered.

Response to Arguments

2. Applicant's arguments filed 5/22/2008 have been fully considered but they are not persuasive. Applicant argues that Yeung et al. offers no disclosure of slots extending the entire lengths between distal and proximal ends of a needle. The Examiner agrees. Unfortunately, the claims of the current application do not recite this limitation. Claim 17 merely requires that the channel have "a longitudinal slot extending between distal and proximal ends" of the channel. As seen in figures 3 and 4, Yeung shows a slot 2 extending longitudinally between the proximal and distal end. The fact the opening does not extend the entire length between the distal and proximal end on both support channels is irrelevant since it is not claimed. As long as there is an opening extending for some distance between the proximal and distal ends, the claim is met. Furthermore, the opening is clearly capable of releasing a cardiac lead laterally therefrom.

3. The applicant further argues that the resilient fasteners are not electrical conductors. However, Yeung discloses that the fasteners are made of stainless steel, which is an electrically conductive metal. Furthermore, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a cardiac lead) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). All that is claimed is a support channel CAPABLE of holding a lead. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

4. Regarding claim 18, as described in the previous office action and below, Starksen was included to show that the delivery of leads laterally from a catheter was known in the art. As a result, it would have been obvious to one of ordinary skill in the art to use the channel of Yeung as a delivery device for the cardiac lead of Starksen, since the operation of Yeung is in no way dependent on what type of device is in the channel, and the cannula of Yeung can be used in combination with the lead to achieve the predicatable results of delivering a lead laterally through the slots to a delivery site.

5. The rejections are still considered proper.

Priority

6. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

7. The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994). The disclosure of the prior-filed application, Application No. 09/635,721, 60/150,737 and 60/148,130, each fail to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for claims 17, 18 and 29 of this application. It is noted that applications 09/635,721, 60/150,737 and 60/148,130 each fail to disclose certain structural features including, for example, first and second separate channels and the second channel having coaxially mounted first and second elongated segments, wherein the first and second elongated segments each have elongated slots. Therefore, the effective filing date for the claims is 5/6/2002.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yeung et al. (WO 00/40159, hereinafter Yeung) in view of Obenchain (US 5,313,962).

12. Yeung discloses (Figures 1-73) an apparatus that is capable of performing an endoscopic procedure on the heart of a patient through a working cavity in tissue between the heart and an entry incision. The apparatus has an elongated cannula (1, Figure 3) configured for passing extravascularly through the entry incision and working

cavity, the cannula having a cylindrical channel (16) and a slot (2) that extends between the distal end and a proximal end (page 8, lines 11-19). The apparatus also has a cylindrical needle (7) that coaxially mate with each other to allow rotation about a coaxial axis so that slot (8) of the needle can rotate into alignment with slot (2) to release an electrical conductor (13). Furthermore, it is the Examiner's position that the slot is fully capable of supporting a cardiac lead, and would allow a cardiac lead to be released from the aligned slots laterally.

13. Yeung fails to disclose an additional separate channel for suction. Obenchain teaches the use of a cannula with multiple separate channels/lumens to accept various devices such as for visualization, aspiration, and suction, of which all are common procedures performed during endoscopic/laparoscopic surgeries. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide for additional channels to receive other surgical tools, at least one of which being for suction in order to consolidate the working area of the patient and minimize possible complications of instruments coming into detrimental contact.

14. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yeung and Obenchain in view of Starksen (US 5,571,161). Yeung, as modified above, discloses the applicant's basic invention with the exception of including a cardiac lead in the endoscopic apparatus. Attention is directed to the reference of Starksen, which discloses an apparatus 10 for performing a surgical procedure on the heart of a patient through a working cavity in tissue between the heart and an entry incision, as shown in figure 8. The tubular body 12 acts as a support channel for cardiac lead E, such that

the channel includes two coaxial mating segments 40 and 12, as shown in figure 3. The segments have slots 36 and 38 extending between distal and proximal ends for selective configuration as a closed channel, as shown in figure 1, and as a channel open longitudinally between the ends for releasing a cardiac lead laterally from the channel (see figure 3 and 8D and Col. 6, lines 1-9). All of the components of claims 17 and 18 are known in Yeung, as modified, and Starksen. The only difference is the combination of the lead of Starksen in the rotatable channel of Yeung. Therefore, it would have been obvious to one of ordinary skill in the art to use the channel of Yeung as a delivery device for the cardiac lead of Starksen, since the operation of Yeung is in no way dependent on what type of device is in the channel, and the cannula of Yeung can be used in combination with the lead to achieve the predicatable results of delivering a lead laterally through the slots to a delivery site.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric D. Bertram whose telephone number is 571-272-3446. The examiner can normally be reached on Monday-Friday from 9:30-6 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl H. Layno can be reached on 571-272-4949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/E. D. B./
Examiner, Art Unit 3766

/Mark W Bockelman/
Primary Examiner, Art Unit 3766
August 27, 2008